

### **REMARKS/ARGUMENTS**

This application now contains claims 1 through 20. Claims 1, 2, 3, 6, 7, 13, 16 and 20 have been amended to address certain Section 112 rejections and claims 13 and 15 have been rewritten in independent form. The remaining claims remain in original form.

Claims 1 through 15, 18 and 19 were objected to under 37 CFR 1.75(i) because each element identified in the claim is not separated by a line indentation. Applicants submit that 37 CFR 1.75(i) simply describes a preferred format for claims and does not require this format to be followed. Applicants specifically point to the use of the word "should"; each element or step of the claim should be separated by a line indentation" (emphasis added). Contrast this with, for example, the wording of 37 CFR 1.75(a); "The specification must.....". Applicants submit that the claims, as presented, are in acceptable form. The objection presented under 37 CFR 1.75(c), directed to claim 13 has been addressed by the above amendments. Claim 13, as amended, is in independent form and claims an additive concentrate composition.

As noted above, the rejections presented under 35 USC Section 112, first and second paragraphs, and the other noted formal objections to the claims are believed to be rendered moot by the above amendments to the claims.

It was noted that, should claim 3 be found allowable, claim 4 would be objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3. Applicants note, however, that the scope of claim 4, which depends from claim 2 and thus contains all limits of both independent claim 1 and claim 2, is of considerably different scope than claim 3, which depends from claim 1 directly and does not include the limitations of claim 2. Therefore, the allowance of claims 4 would not constitute a double patenting of subject matter allowed in claim 3.

Claims 16, 17 and 20 were withdrawn in response to a restriction requirement.

No prior art was cited against claim 15. Claim 15 has been amended to independent form to include all limitations of original claim 1. Applicants submit that claim 15 is now in condition for allowance.

The invention is directed to the discovery that the presence of salts of certain dihydrocarbyldithiophosphoric acids, in combination with molybdenum compounds, provides a synergistic friction modifying effect in lubricating oil compositions. This effect is clearly demonstrated by the test data summarized in Table 2 of the present specification (page 23). As shown, salts of dihydrocarbyldithiophosphoric acids within the scope of the present claims, alone, display no greater friction modifying effect than salts of dihydrocarbyldithiophosphoric acids that are outside the scope of the claims (compare friction values achieved with Oils 1 and 2 to those noted with Oils 3 and 4). In fact, the inventive salts, in the absence of the molybdenum compound actually display a reduced ability to reduce friction. In contrast, as shown by a comparison between the results achieved with Oils 5 and 6, and Oils 7 and 8 (which represent the invention), the salts of dihydrocarbyldithiophosphoric acids in accordance with the present invention, in combination with a molybdenum compound provide reduced friction compared to the oils containing a combination of a molybdenum compound and salts of dihydrocarbyldithiophosphoric acids that are outside the scope of the present claims. As is further shown, the use of a combination of the molybdenum compound and the inventive dihydrocarbyldithiophosphoric acid salts reduces friction relative to the use of inventive dihydrocarbyldithiophosphoric acid salts, alone, while the use of a combination of a molybdenum compound and a non-inventive dihydrocarbyldithiophosphoric acid salts is shown to provide substantially no reduction in friction relative to the use of a dihydrocarbyldithiophosphoric acid salt outside the scope of the invention, in the absence of the molybdenum compound.

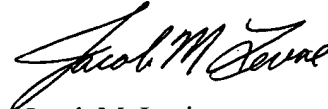
Claims 1 through 14, 18 and 19 were rejected under 35 USC 103(a) as being unpatentable over EP 322235A2 to Colclough (hereinafter "the Colclough patent") in view of either WO 99/31113A1 to McConnachie et al. (hereinafter "the McConnachie et al. application") or U.S. Patent No. 6,358,894 to Leta et al. (hereinafter "the Leta et al. patent"). The Colclough patent was cited for describing a class of dihydrocarbyldithiophosphoric acid salts including some falling within the scope of the present claims, and others that do not. The Colclough patent does not distinguish between the inventive salts and the others. These salts are described as useful, generally in lubricants, which may contain other additives, which may include friction modifiers, which can be organic friction modifiers, but may also be molybdenum-containing compounds. Each of the McConnachie et al. application and the Leta et al. patent describes preferred molybdenum dithiocarbamate compounds of the present invention. The Colclough patent fails to in any manner suggest that the salts of the present invention provide any effect relative to non-

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inventive salts, when used in combination with molybdenum compounds. The McConnachie et al. application and the Leta et al. patent do not suggest that molybdenum compounds provide any effect when used in combination with the inventive salts that is different from that noted when non-inventive salts, or no salts at all, are employed. Thus, at best, it can be alleged that a *prima facie* case of obviousness has been presented, which is fully rebutted by the demonstration of surprising and unexpected results provided by the comparative data of the specification, as discussed *supra*. In view of said data, applicants submit that the rejections presented under Section 103 should now be withdrawn.

Based upon the foregoing, applicants submit that the present claims are in good formal order and fully distinguish over the cited combinations of prior art references. Applicants therefore request that all rejections be withdrawn and that the application now be passed to issue.

Respectfully submitted,



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